

## Notice of Allowability

Application No.

09/975,699

Examiner

Matthew A. Thexton

Applicant(s)

MAHMUD ET AL.

Art Unit

1714

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to response filed 21 July 2003.
2. ☒ The allowed claim(s) is/are 59-81 and 95-117.
3. ☒ The drawings filed on 11 October 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

- |  |   |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____             |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____               | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                  |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
|  | 9 <input type="checkbox"/> Other  |

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## **DETAILED ACTION**

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Luke A. Kilyk, at 540-428-1701, on 26 August 2003.

Claims 82-94 and 118-130 have been canceled.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 21 July 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patent 6,057,387 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Information Disclosure Statement***

In the response filed 21 July 2003, at pages 7-8, Applicant provides US equivalents for five foreign language patent documents, a machine language translation of an unidentified source abstract of DE 2403545, and an EPO source abstract for DE 3502494. The US equivalents have been cited on the USPTO form-892 accompanying this communication. A Derwent abstract has been obtained and cited for DE 2403545. The EPO source abstract has been cited.

### ***Allowable Subject Matter***

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Claims 59-81 and 95-117 are allowed.

The following is an examiner's statement of reasons for allowance:

Applicant has presented claim 95 in this application that is identical to claim 1 in US 6057387 with the exception of the concluding phrase in claim 95: "...wherein said aggregate has silanol groups located at the surface of the aggregate." This phrase has no precedence in the patent applications from which this application claims priority under 35 USC 120. Applicant asserts that the property is inherent and therefore does not constitute new matter.

In view of the holding and findings of *Schering Corp. v. Geneva Pharmaceuticals, Inc., et al.*, 02-1540.doc (Fed. Cir., August 1, 2003) it is concluded that Applicant is correct. Accordingly, the rejection under 35 USC 112 is withdrawn. Further, Applicant is entitled to continuation status rather than continuation-in-part.

The nonstatutory double patenting rejection is obviated by the receipt of a terminal disclaimer which has been recorded.

The double patenting rejection based on 35 USC 101 is withdrawn since, as Applicant points out, the claims are not the same.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Thexton whose telephone number is 703-305-5085. The examiner can normally be reached on Monday-Thursday, 8:30 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasudevan S Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Matthew A. Thexton  
Primary Examiner  
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